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# BEFORE THE BOARD OF PATENT APPEALS
# AND INTERFERENCES

Application Number: 09/919,153
Filing Date: July 31, 2001
Appellant(s): SCHRECKENGAST ET AL.

Eileen Lehmann
For Appellant

## EXAMINER'S ANSWER

This is in response to the appeal brief filed November 2, 2006 appealing from the Office action

mailed March 6, 2006.

## (1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

## (2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

## (3) Status of Claims

The statement of the status of claims contained in the brief is correct.

## (4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

## (5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

## (6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

## (7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

## (8) Evidence Relied Upon

No evidence is relied upon by the examiner in the rejection of the claims under appeal.

### (9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

### *Claim Rejections - 35 USC § 101*

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 1-27 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

Claim 1 recites an information utility, the language of the claim raises a question as to whether the claim is directed merely to an abstract idea and does not result in a practical application producing a concrete, useful, and tangible result to form the basis of statutory subject matter under 35 U.S.C. 101. All of the elements and features of the claim can be implemented in software alone, thus it does not provide for tangible subject matter. Claim 19 recites a method. However, the language of the method claimed raises a question as to whether the claim is directed merely to an abstract idea that does not result in a practical application producing a concrete, useful, and tangible result to form the basis of statutory subject matter under 35 U.S.C. 101. Furthermore, the method does not produce a tangible result since it does not require the use of any particular tangible hardware or structure.

The applicant amended the claims to include the term "computing system". However the addition of this term does not overcome the rejection because the term "computing system" is a broad term which does not limit the subject matter merely to a machine (see applicant's remarks p. 17) since a person's abstract idea could be construed as a computing system since a person can compute.

### *Claim Rejections - 35 USC § 102*

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the

basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

As best understood, claims 1-27 are rejected under 35 U.S.C. 102(b) as being anticipated

by Amazon.com.

As concerns claim 1, a proprietary information utility comprising: an interface (display

interface of website presented to a computer) that provides outside entities connection to the

proprietary information utility; a repository (storage medium storing the webpages and data)

that contains proprietary information, wherein the repository is compartmentalized by user

identity and entitlement, so that a first category of proprietary information is within private

domains (private data) available to only a single user and a second category of proprietary

information is within domains to which multiple users (public data) may be granted use in

response to acquiring a license to use particular proprietary information within the second

category of proprietary information; application services (searching the webpages); a security

system (secure webpages and data), that limits access of each user connecting to the proprietary

information utility to proprietary information to which each user is entitled, the proprietary

information to which each user is entitled being accessed through use of the application

services; and, a billing system (billing system for purchasing products/services from website)

for tracking usage by users of the proprietary information utility for billing purposes.

As concerns claim 2, a proprietary information utility as in claim 1 wherein the second category of proprietary information includes decision support software (website runs off software).

As concerns claim 3, a proprietary information utility as in claim 1 wherein the application services include services to perform at least one of the following activities related to patents: help identify patentable ideas; create patent disclosures; manage pending patents; manage research logs; and, research existing patents (search for books on patents).

As concerns claim 4, a proprietary information utility as in claim 1 wherein the application services include at least one of the services listed below: decision support software; software for troubleshooting products; system configuration services; diagnostic services; planning services; selection services; authoring tools that help authors generate appropriate software models; learning services for data-mining and the ongoing evolution of models; business intelligence services; version management services; presentation services; brokering services; stock selection services; investment portfolio troubleshooting services; investment portfolio selection services; services to troubleshoot devices; medical diagnosis services; services that predict failure and behavior; purchasing decision services; consulting services; skills gap analysis services; translation services for translating decision support models from one underlying technology to another; enterprise resource planning services; and, customer relationship management services (search for books on investment portfolio).

As concerns claim 5, a proprietary information utility as in claim 1 wherein the first category of proprietary information contains health records and the application services

include services to provide services for supporting healthcare and patients, without revealing

private information (books on health in a users cart).

As concerns claim 6, a proprietary information utility as in claim 1 wherein the second

category of proprietary information includes proprietary information within at least one

of the areas listed below: decision support models; and, models associated with troubleshooting

products (books on decision support models).

As concerns claim 7, a proprietary information utility as in claim 1 wherein the second

category of proprietary information includes decision support models that are based on at least

one of the technologies listed below: Bayesian networks; neural networks; case-based systems;

model-based systems; rule-based systems; fuzzy systems; decision trees; genetic algorithms;

Monte Carlo Markov chains; clustering algorithms; Monte Carlo optimization; simulated

annealing; pattern matching; influence diagrams; online analytical processing; collaborative

filtering; linear programming; machine learning; and, time series (books on Bayesian networks).

As concerns claim 8, a proprietary information utility as in claim 1 wherein the interfaces

allows users to connect to the proprietary information utility using at least one of the following

deployment channels: wireless network; cellular phones; internet sites; applications embedded

in appliances; applications embedded in devices; applications embedded in vehicle

communication and information systems; applications embedded in intelligent agents; and,

applications embedded in memory modules (internet sites).

As concerns claim 9, a proprietary information utility as in claim 1 wherein the

application services include services to support the creation, maintenance, and deployment

of decision support models, in at least one of the following areas: data-mining; usage reports;

business intelligence reports; adaptive learning and refining of models; authoring wizards

particular to specific horizontal and vertical industries; and, quality benchmarks of models

(books on data-mining).

As concerns claim 10, a proprietary information utility as in claim 1 additionally

comprising: an application service registry that manages dynamic registration, access, use,

and disposal of the application services (site keeps of items viewed).

As concerns claim 11, a proprietary information utility as in claim 1 additionally

comprising: a proprietary information broker that maps semi-structured proprietary

information requests to a most appropriate proprietary information model and application

services that will operate on the most appropriate proprietary information model (website lists

related products to desired products).

As concerns claim 12, a proprietary information utility as in claim 1 wherein the security

system provides non-repudiation services in support of billing and reporting (billing information

entered on a secure site).

As concerns claim 13, a proprietary information utility as in claim 1 wherein the security

system provides privacy for all information transmitted outside of the proprietary information

utility, allowing proprietary services to make use of proprietary in formation utility without

revealing anything about users of the proprietary services and without revealing contents of data

moving between services (private data is secure not un-secure public data).

As concerns claim 14, a proprietary information utility as in claim 1 wherein the billing

system provides revenue to be generated using at least one of the following pricing schemes:

pay-per-use micro-transactions; vendor-visible service-based pricing; hybrid flows;

subscription-based pricing; and, price bundling (subscription based pricing for a user ordering a

magazine subscription).

As concerns claim 15, a proprietary information utility as in claim 1 additionally

comprising: a scaleable computing engine that runs services across many pieces of

information (search engine for website).

As concerns claim 16, a proprietary information utility as in claim 1 additionally

comprising: a computing engine, the computing engine being used to translate information from

an author into a utility-native proprietary information format that can be used by a least a subset

of application services within the proprietary information utility (search terms entered into

search engine on website).

As concerns claim 17, a proprietary information utility as in claim 1 wherein the billing

system calculates royalty payments due to authors when proprietary information of the authors

is used by the application services within the proprietary information utility (authors receive

royalty payments based on books sold).

As concerns claim 18, a proprietary information utility as in claim 1 additionally

comprising an application service registry that manages dynamic registration, access, use,

and disposal of the application services, the application service registry providing a service

catalog, a discovery mechanism, and a brokering interface that links with the proprietary

information broker and the security system to provide a custom view of available application

services; based on entitlement and visibility (wish list or items in cart or items resulting from a

search).

As concerns claim 19, a method comprising the following steps: (a) providing outside

entities connection to a proprietary information utility (connect to website); (b) storing

proprietary information within a repository, wherein the repository is compartmentalized by

user identity and entitlement (memory storing data relating to users; wish list; items ordered);

(c) limiting access of each user connecting to the proprietary information utility to proprietary

information to which each user is entitled, the proprietary information to which each user is

entitled being accessed through use of application services operating within the proprietary

information utility (private data; users account), wherein multiple users can be granted access to

the same proprietary information (public users may access books and items sold on website;

wherein a private user may buy the same products); and, (d) tracking usage of users of the

proprietary information utility for billing purposes (users cart on website).

As concerns claim 20, a method as in claim 19 additionally comprising the following

step: (e) managing dynamic registration, access, use, and disposal of the application services

(user sets up an account).

As concerns claim 21, a method as in claim 19 additionally comprising the following

step: (e) mapping semi-structured proprietary information requests to a most appropriate

proprietary information model and application services that will operate on the most appropriate

proprietary information model (website lists related products to desired products).

As concerns claim 22, a method as in claim 19 wherein step (c) includes providing

non-repudiation services in support of billing and reporting (user enters payment info).

As concerns claim 23, a method as in claim 19 wherein step (c) includes providing

privacy for all information transmitted outside of the proprietary information utility, allowing

proprietary services to make use of proprietary information utility without revealing anything about users of the proprietary services and without revealing contents of data moving between services (private data transmitted securely; entered on a secure webpage).

As concerns claim 24, a method as in claim 19 wherein step (d) includes providing revenue to be generated using at least one of the following pricing schemes: pay-per-use micro-transactions; vendor-visible service-based pricing; hybrid flows; subscription-based pricing; and, price bundling (subscription based pricing for a user ordering a magazine subscription).

As concerns claim 25, a method as in claim 19 additionally comprising the following step: (e) translating information from an author into a utility-native proprietary information format that can be used by a least a subset of application services within the proprietary information utility (webpage presents text from books in another format for viewing on the webpage).

As concerns claim 26, a method as in claim 26 wherein step (d) includes calculating royalty payments due to authors when proprietary information of the authors is used by the application services within the proprietary information utility (author receives royalty payments based on number of books sold).

As concerns claim 27, a method as in claim 19 additionally comprising the following step: (e) providing a service catalog, a discovery mechanism to provide a custom view of available application services, based on entitlement and visibility (user can search by topic).

### (10) Response to Argument

***The Appellant argue the claims fall within one of the statutory classes of invention under 35 U.S.C. 101.***

As concerns claims 1-18, the Appellant states the proprietary information utility computing system is claimed as a machine (e.g., comprises systems such as an interface exchange system, a security system and a billing system) (Appeal brief; page 6, paragraph 1).

The recital of a computing system is not necessarily drawn to a physical computer device, i.e. hardware, which is a machine. A system does not invoke that the system be a physical system or machine, since a system can be defined as a method, scheme or plan of procedure and the claim does not recite that it is drawn to a machine, manufacture and composition of matter that define things or products. The appellant has not identified any particular passage in the specification or limitations in the claim that would identify the "computer system" as a "machine". In light of the specification, which recites "software applications" (specification p. 1), website and services (specification p. 6, lines 6-10), and in view of the language of the claims, the claimed subject matter appears drawn to software or a computer program, which is an abstract idea that is not in one of the statutory classes of invention.

The claimed subject matter does not provide for a physical transformation, since the claim does not transform an article or physical object to a different state or thing.

The claimed subject matter lacks a practical application of a judicial exception (abstract idea) since it fails to produce a useful, concrete and tangible result. Specifically, the claimed subject matter does not produce a tangible result because the claimed subject matter fails to produce a result that is limited to having real world value rather than a result that may be

interpreted to be abstract in nature as, for example, a thought, a computation, or manipulated

data. More specifically, the claimed subject matter provides for a billing system for tracking

usage by users of the proprietary information utility computing system for billing purposes. This

produced result remains in the abstract and thus fails to achieve the required status of having real

world value. The recitation of "for tracking" and "for billing" are not positive limitations since

the actual result of "tracking" and "billing" are not realized.

The Appellant states, as described in the specification, the claimed invention produces

several examples of final results that are useful, concrete and tangible (Appeal brief; page 6,

paragraph 2). The Appellant has not indicated specifically where in the specification these can be

found. Also, the Appellant has not indicated where in the claims, specific limitations are found,

that recite a useful, concrete and tangible result.

The Appellant states "the proprietary information utility computing system is providing a

real world result of allowing a user access to proprietary information in a repository based on the

user's entitlement to the information" (Appeal Brief; page 6, paragraph 2). The claims do recite

this particular limitation. Furthermore this is not a final result set forth by the claim.

The appellant also states "real world systems form part of this computing system such as

an interface...a security system...and a billing system". These are not actual final results that

provide useful, concrete and tangible results but appear to be steps or elements for producing a

result. The "interface" is claimed as part of the computing system but it is not a result. The

interface is claimed as providing the function of "provides outside entities connection to the

proprietary information utility computing system". The interface is a broad term that one of

ordinary skill in the art would convey the term to be any surface or boundary that provides

communication or interaction. These definitions for an interface need not be a physical structural item, particularly even not within a physical computer device since the applicant has claimed a "computing system" not a computer. The appellant argues a billing system for the real world result of billing (Appeal brief; page 6, paragraph 2, last 2 lines). As recited in the claims since the step or element of the billing system recites the functional language of "for billing", the result of "billing" is never actually realized.

As concerns claim 19-27, the claims recite a method implemented by a computing system. In light of the specification, which recites "software applications" (specification p. 1), website and services (specification p. 6, lines 6-10), and in view of the language of the claims, the claimed subject matter appears drawn to an embodiment that covers software or a computer program, which are an abstract idea that is not one of the statutory classes of invention.

The claimed subject matter does not provide for a physical transformation, since the claim does not transform an article or physical object to a different state or thing.

The claimed subject matter lacks a practical application of a judicial exception (abstract idea) since it fails to produce a useful, concrete and tangible result. Specifically, the claimed subject matter does not produce a tangible result because the claimed subject matter fails to produce a result that is limited to having real world value rather than a result that may be interpreted to be abstract in nature as, for example, a thought, a computation, or manipulated data. More specifically, the claimed subject matter provides for tracking usage of users of the proprietary information utility for billing purposes. This produced result remains in the abstract and thus fails to achieve the required status of having real world value. The limitation of "tracking...for billing purposes" appears to be a step and there is no real world result that is

realized. The step of tracking appears to be some computation or manipulation of data. The

recitation of "for billing" is not a positive limitation since the actual result of billing a user is

never realized.

The Appellant states "the method of claim 19 implemented by a computer system (a

machine)" (Appeal brief; page 6, paragraph 3). The appellant has not identified any particular

passage in the specification or limitations in the claim that would identify the "computer system"

as a "machine". A system does not invoke that the system be a physical system or machine, since

a system can be defined as a method, scheme or plan of procedure and the claim does not recite

that it is drawn to a machine, manufacture and composition of matter that define things or

products. In light of the specification, which recites "software applications" (specification p. 1),

website and services (specification p. 6, lines 6-10), and in view of the language of the claims,

the claimed subject matter appears drawn to software or a computer program, which are an

abstract idea that is not one of the statutory classes of invention.

Furthermore, the claims do not recite an appropriate computer readable medium, physical

structure, to define a structural and functional interrelationship between a computer program and

other elements of a computer that permit the functionality of the computer program to be

realized.

*The Appellant argues claims 1-27 are not anticipated by Amazon.com.*

As concerns independent claims 1 and 19, Amazon (www.amazon.com; October 13,

1999; wayback machine for amazon.com; (total-4 pages)) does not disclose or suggest a

proprietary information utility computing system including a repository that contains proprietary

information. The examiner disagrees since Amazon discloses a repository (stored information for

the website) is compartmentalized by user identity ("your account" feature of website), so that a

first category of information is within private domains available only to a single user (your

account available only to that user of the account) and a second category of proprietary

information (public data in auctions) is within domains to which multiple users may be granted

use in response to acquiring a license to use (register for auction) particular proprietary

information.

The appellant argues the second category of proprietary information is not the same as

public data available on amazon.com home page (Appeal brief; page 7, paragraph 6). The

appellant further argues "public" information of Amazon is not proprietary information and is

not within domains to which multiple users may be granted use in response to acquiring a license

to use particular proprietary information. The examiner disagrees since information pertaining to

a particular proprietor is posted as public data, such that potential customers can view it. This

information can be in domains, such as auctions, wherein multiple users may be granted access

to view, in response to acquiring a license, such as registering to enter the auction.

The appellant argues Amazon does not provide an equivalent for application services.

The examiner disagrees since Amazon discloses tabs for searching web pages of the site that

include gift services.

The appellant argues Amazon does not disclose "for tracking usage by users of the

proprietary information utility computing system for billing purposes." The examiner disagrees

since Amazon discloses a cart that tracks the users usage of items that are entered into the cart
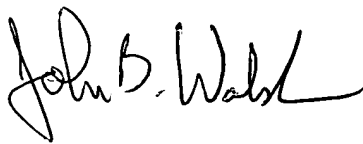
for billing purposes.

**(11) Related Proceeding(s) Appendix**

No decision rendered by a court or the Board is identified by the examiner in the Related

Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,
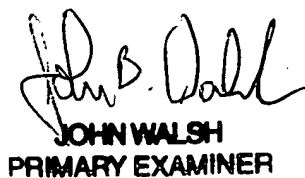
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